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EXAMINER

ROSSI, JESSICA

ART UNIT

PAPER NUMBER

3733

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,242

Applicant(s)

ST. JOHN, CALI

Examiner

Jessica L. Rossi

Art Unit

1733

ed

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 463 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: copy of written translation.

DETAILED ACTION

Request for Continued Examination

1. The request filed on 11/10/03 for a RCE under 37 CFR 1.114 based on parent Application No. 09/637,242 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. This action is in response to the amendment dated 12/17/03. Claims 18-20 were added. Claims 1-20 are pending. It is noted that no new matter has been presented.

3. The rejections of claims 1-17 under 35 U.S.C. 112 1st and 2nd paragraphs, as set forth in paragraphs 4-5 of the previous office action, have been withdrawn because Applicants deleted "highly" from the claims.

4. The rejection of claims 1-2, 4-5, 12, and 14-15, under 35 U.S.C. 103(a) as being unpatentable over Reumer (of record) in view of Granofsky (of record) and the collective teachings of Blotky (of record) and Bozlee (of record), or alternatively, Granofsky in view of Reumer and the collective teachings cited above, as set forth in paragraph 7 of the previous office action, has been withdrawn because of the discovery of other prior art upon further searching.

Election/Restrictions

5. Newly submitted claim 20 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claim 20 is directed to a sanitary cover for sealed beverage containers while the original invention is directed to a business method relating to beverage containers. Therefore, the

sanitary cover as claimed can be used in a materially different process of using that product such as one where the manufacturer of the cover attaches the indicia thereon and therefore does not convey by profit making sale a right to attach indicia to the cover (MPEP 806.05(h)).

Alternatively, the cover as claimed can be used in a materially different process such as one relating to food containers.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 20 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

6. Claim 3 is objected to because of the following informalities: "can" should be changed to --container-- in line 11 to maintain consistency throughout claim. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-3, 5-6, 9-10, 12, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kagami (JP 6-171650) in view of Bozlee (US 6354645; of record).

With respect to claim 1, Kagami is directed to a business method relating to beverage containers 1 having sealed apertures (note pull tab 2 in Figure 3; [0006] of written translation). The reference teaches the beverage manufacturer selling the right to sponsors to attach indicia (i.e. advertising) to consumer removed, flexible protective members 5 to be adhered to the sealed

containers ([Figures 3-4; [0006] and [0012] of written translation), manufacturing the protective members, applying indicia to the protective members ([0007] of written translation), and adhering the protective members to the containers ([0010] of written translation) to form a substantially wrinkle free skin tight seal between the protective member and at least a portion of a mouth contact area of the containers (note similarities between shape of protective member described in second embodiment depicted in Figures 3-4 of reference and protective member depicted in Figures 1 and 4 of present invention; also noted how both members conform to container in similar manner).

The reference teaches the advertisement revenue covering the cost of the protective members but is silent as to whether or not the revenue exceeds the cost of the members, such that profit is generated by the advertising ([0012] of written translation).

The skilled artisan would have readily appreciated that the concept of selling something (tangible or intangible) at a price that exceeds the cost of doing business is a survival technique practiced by all in a capitalist economy. Almost everything we purchase is "marked-up" such that the money generated by the sale of the product produces a revenue stream capable of offsetting production costs and/or generating profit. As for a person or company generating profit by selling advertising space, the skilled artisan would have appreciated that such is also a well known and readily practiced business method (i.e. possessor of billboard generates profits by selling advertising space on billboard to another person or company; TV network generates profits by selling "air-time" to companies allowing them to air commercials promoting their products and/or services).

For example, it is known to engage in a method of doing business where the producer of a product, such as a bag handle, sells the right to a third party, such as a pizza company, to advertise their pizza on the bag handles, which the handle producer gives to a grocery store for attaching to their grocery bags, as taught by Bozlee (Figure 2; column 3, lines 1-5 and 22-26 and 36-38). The money generated by selling advertising rights to the third party allows the handle producer to give the handles away freely to stores, thereby solving the market penetration problem experienced with low margin grocers and other stores (column 3, lines 34-38). One reading the Bozlee reference as a whole would have appreciated that the revenue generated by selling the advertising rights to third parties must be offsetting the cost of making the handles in addition to generating profit; otherwise, the handle maker would not be able to stay in business since no company can survive long-term just by breaking even.

While the examiner appreciates that selling of the beverage containers themselves will generate profit for the beverage manufacturer discussed in Kagami, it would have been obvious to the skilled artisan at the time the invention was made to have the revenue stream generated by selling advertising rights to the sponsors in the business method of Kagami be a revenue stream that also generates profit in addition to offsetting the cost of the protective members because selling advertising rights for profit is well known and readily practiced in the business world, as discussed in the previous paragraphs and as evidenced by Bozlee, wherein the generation of profits is critical to a company's long-term survival and/or success.

Regarding claim 2, Kagami teaches selling the right to third parties (i.e. an enterprise or organization who are neither the beverage manufacturer, distributor, grocery store owner who sells the beverage to consumers, consumer, etc.; [0012] of written translation).

With respect to claim 3, all the limitations were addressed above with respect to claim 1, except the protective members being in an hourglass configuration. Kagami teaches the protective members being in an hourglass configuration to facilitate adherence to the top and convex side of a container without deformation and without wrinkling of a material of the protective member by folding it over a rim of a beverage container when adherence occurs (Figures 3-4; section [0010] of written translation; note similarities between shape of protective member of reference as shown in Figures 3-4 and protective member of present invention as shown in Figures 1 and 4 and how both conform to container in similar manner).

Regarding claim 5, Kagami teaches the indicia being advertising ([0007] of written translation).

Regarding claim 6, Kagami teaches applying the indicia by printing ([0007] of written translation).

Regarding claim 9, Kagami teaches applying the printed indicia to a reverse side (= underside) of the protective members ([0007] of written translation).

Regarding claim 10, Kagami teaches the protective member can be "non-transparent" (= opaque; last sentence of [0006] of written translation). Therefore, the skilled artisan would have appreciated that the indicia printed on the underside of the member would not be visible until the member is removed.

Regarding claim 12, Kagami teaches adhering the protective members to the containers using adhesive ([0010] of written translation).

With respect to claim 16, all the limitations were addressed above with respect to claim 3.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kagami and Bozlee as applied to claim 1 above and further in view of Kinoian et al. (US 3690509).

Regarding claim 4, Kagami is silent as to sanitizing at least a mouth contact portion of the cans. It would have been obvious to the skilled artisan at the time the invention was made to sanitize at least a mouth contact portion of the cans because sanitizing the entire can is known in the art, as taught by Kinoian (column 3, lines 40-45), wherein such treatment ensures a sanitary drinking surface.

10. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kagami and Bozlee as applied to claim 6 above and further in view of Burns (US 6127437; of record).

Regarding claims 7-8, Kagami is silent as to treating the protective members so that the same accepts and retains printing ink.

It is known to treat a plastic closure for a liquid container using corona discharge so that the closure accepts and retains printed matter, as taught by Burns (Figure 1; column 2, lines 51-56; column 5, lines 46-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to treat the plastic protective member of Kagami (note member can be made from resin; [0006]) using corona discharge so that the member accepts and retains printed matter because such is known, as taught by Burns, and this ensures that the desired indicia is successfully printed and retained on the member.

11. Claims 11, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kagami and Bozlee as applied to claim 10 above and further in view of Ruemer (US 4402421; of record).

Regarding claim 11, Kagami is silent as to the indicia being used for such things as those recited in the present claim.

It is known in the art to cover the top of a beverage container with a protective member bearing indicia used for such things as redeemable prizes, as taught by Ruemer (Figure 4; column 2, lines 23-25 and 49-51). One reading Kagami as a whole would have appreciated that the reference is not limited to any particular type of advertising and therefore it would have been obvious to the skilled artisan at the time the invention was made to have the indicia printed on the underside of the members of Kagami be used for such things as redeemable prizes without the user knowing in advance of protective member removal which of a plurality of chances the user has obtained because such is known in the art, as taught by Ruemer, wherein such things peek the curiosity of consumers thereby increasing sales.

Regarding claim 17, all the limitations were addressed above with respect to claims 1-2 and 9-11.

Regarding claim 19, it is noted Kagami teaches one of the benefits of adhering the protective members to the containers is that the adhesive allows the members to remain partially adhered to the containers even after they are partially removed to expose the pour spout, thereby allowing the member to be recycled along with the containers ([0005] of written translation).

However, the examiner would have appreciated that the portion of the protective members that does not require removal to expose the pour spout would be capable of being removed, just like the portion that is removed to expose the pour spout, since the same adhesive is used to adhere all portions of the member to the container. Therefore, the examiner would have appreciated that the members of Kagami would be capable of being completely removed

from the containers and collected by a consumer if he/she chose to do so (perhaps he/she collects advertisements for a hobby); it being noted that protective members that are capable of remaining attached to beverage containers to avoid litter while also being capable of removal for collection or redemption of prizes is known in the art, as taught by Ruemer (column 2, lines 54-56).

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kagami and Bozlee as applied to claim 12 above and further in view of Takayama (US 6015059; of record).

Regarding claim 13, Kagami is silent as to the adhesive being antibacterial. It would have been obvious to the skilled artisan at the time the invention was made to use an antibacterial adhesive for the adhesive of Kagami because such is known in the art, as taught by Takayama (column 3, lines 26-31), wherein this prevents any bacterial growth from forming in the areas having adhesive thereon.

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kagami and Bozlee as applied to claim 1 above and further in view of Dronzek (US 5925208) and Sommers (US 6620281).

Regarding claim 14, Kagami is silent as to imposing anti-static chemical treatment on the protective members.

It is known to impose anti-static chemical treatment to adhesively backed labels having indicia printed thereon (note protective members similar to adhesively backed labels), as taught by Dronzek (column 8, lines 30-35 and 65-68). Therefore, it would have been obvious to the skilled artisan at the time the invention was made to impose anti-static chemical treatment to the label-like protective members of Kagami because such is known, as taught by Dronzek, wherein

this would produce the expected results of preventing unwanted sticking/clinging. The skilled artisan would have appreciated that like the anti-static chemically treated members of the present invention, the anti-static chemically treated members of Kagami would also slide easily from an adjoining member and not cling to it under high speed dispensing.

The examiner would like to point out that the present claim language is not positively claiming a method step of high speed dispensing of adjoining protective members. However, to expedite prosecution, the examiner would like to point out that it is known in the art to apply an adhesively-backed label to a beverage can using a cut and stack method that involves high speed dispensing of labels placed on top of each other in a stack, as taught by Sommers (Figure 5; column 3, lines 22-25; column 4, lines 16-28). Therefore, it would have been obvious to the skilled artisan at the time the invention was made to apply the label-like protective members of Kagami using a cut and stack method because such is known in the art, as taught by Sommers, wherein this method allows for high speed application of the members (Sommers; column 4, lines 25-28).

14. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kagami and Bozlee as applied to claim 1 above and further in view of Kinoian et al. and Miyazaki et al. (US 5863624).

Regarding claim 15, Kagami is silent as to these limitations.

The prior art is concerned with the absence of adhesive residue on the surface of the can once the protective member is removed, as evidenced by Kinoian (column 3, lines 19-24). Kinoian ensures this by using an adhesive which bonds more strongly to the member and less strongly to the can (column 3, lines 19-24). However, it is also known in the label art to increase

bonding strength between an adhesive and a plastic by imposing treatment to the surface of the plastic before applying the adhesive thereto, as taught by Miyazaki (column 1, line 21; column 2, lines 64-68; column 5, lines 17-20; column 6, lines 15-18).

It would have been obvious to the skilled artisan at the time the invention was made to ensure a stronger bond between the protective members of Kagami (note members can be made from resin; [0006]) than that which exists between the adhesive and cans because such is known in the art, as taught by Kinoian, wherein this prevents adhesive residue being left behind on the surface of the can. Furthermore, it would have been obvious to the skilled artisan to treat the protective members of Kagami to achieve this goal because such is known in the art, as taught by Miyazaki, wherein this serves as an alternative to using a particular adhesive that bonds more strongly to the members, thereby increasing the types of adhesives that can be used. As for a particular type of treatment, such would have been within purview of the skilled artisan at the time the invention was made absent any unexpected results; it being noted that chemical treatment (i.e. use of primers) is well-known and conventional.

15. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kagami, Bozlee, and Ruemer as applied to claim 17 above, and further in view of Takayama.

Regarding claim 18, Kagami teaches the member remaining partially stuck to the can after exposing the pour spout ([0011] of written translation), but is silent as to the adhesive allowing for reattachment of the portion that was removed from the can. It would have been obvious to the skilled artisan at the time the invention was made to use an adhesive that allows for reattachment of the portion of the member that was removed to expose the pour spout because such is known in the art, as taught by Takayama (column 3, lines 1-7), wherein this

prevents contamination of the contents within the can while also allowing for storage of an unfinished beverage until a later time.

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims 1-3, 5-10, 12-14, and 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 11-12, 15-16, and 19 of copending Application No. 10/360,488 in view of Kagami and Bozlee.

With respect to claim 1, all the limitations are taught by claims 1 and 5 of the copending application except the container having sealed apertures, the revenue being profit, the protective member being flexible, and there being a skin tight seal between the member and at least a contact portion of a mouth contact area of the container. Applicant is directed to paragraph 8 above for a complete discussion of Kagami and Bozlee.

It would have been obvious to the skilled artisan at the time the invention was made for the cans to have sealed apertures, the protective members to be flexible, and there to be a skin tight seal between the member and at least a contact portion of a mouth contact area of the can

because such is known in the art, as taught by Kagami, wherein such characteristics allow for good conformance of the member to the can thereby keeping the same sanitized.

As for the revenue being profit, Applicant is directed to paragraph 8 above.

Regarding claim 2, this limitation is taught by claim 2 of the copending application.

With respect to claim 3, all the limitations were addressed above with respect to claim 1, except the member being in an hourglass configuration to facilitate adherence to a top and convex side of a container without deformation and without wrinkling of a material of the protective member by folding it over a rim of a beverage container when adherence occurs.

Claim 3 of the copending application teaches all these limitations except folding the member over the rim of the container when adherence occurs. It would have been obvious to do so because such is known in the art, as taught by Kagami, and allows for a good fit between the can top and member.

Regarding claim 5, this limitation is taught by claim 11 of the copending application.

Regarding claim 6, this limitation is taught by claim 15 of the copending application.

Regarding claims 7-8, these limitations are taught by claim 16 of the copending application.

Regarding claims 9-10, the copending application is silent as to these limitations. It would have been obvious to use an opaque protective member having printing on the underside thereof because such is known in the art, as taught by Kagami in paragraph 8 above, wherein this peeks the curiosity of the consumer thereby increasing sales.

Regarding claim 12, this limitation is taught by claim 20 of the present application.

Regarding claim 13, this limitation is taught by claim 12 of the copending application.

Regarding claim 14, this limitation is taught by claim 19 of the copending application.

Regarding claim 16, all the limitations were addressed above with respect to claim 3.

This is a provisional obviousness-type double patenting rejection.

18. Claims 4 and 15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, and 20 of copending Application No. 10/364,488 in view of Kagami and Bozlec as applied to claim 1 above and further in view of Kinoian et al.

Regarding claim 4, the copending application is silent as to this limitation. Applicants are directed to paragraph 9 above. It would have been obvious to the skilled artisan at the time the invention was made to sanitize at least a mouth contact portion of the cans because sanitizing the entire can is known in the art, as taught by Kinoian, wherein such treatment ensures a sanitary drinking surface.

Regarding claim 15, claim 20 of the copending application teaches all the limitations except no adhesive residue being left on the container after removal of the member. Applicants are directed to paragraph 14 above for a complete discussion of Kinoian. It would have been obvious to the skilled artisan to achieve such a result upon removal of the member because such is known in the art, as taught by Kinoian, wherein this prevents the consumer from coming into contact with adhesive.

This is a provisional obviousness-type double patenting rejection.

19. Claims 11 and 17-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 11, and 13 of

compending Application No. 10/360,488 in view of Kagami and Bozlee as applied to claims 1-2 and 9-10 above and further in view of Ruemer.

Regarding claim 11, claim 11 of the compending application teaches the indicia relating to such things but is silent as to the indicia being on the underside of an opaque member. Applicants are directed to paragraph 11 above for a complete discussion of Ruemer. It would have been obvious to the skilled artisan at the time the invention was made to have the underside printing on the opaque member of Kagami relate to such things recited by the compending application because such is known in the art, as taught by Ruemer, wherein this peeks the curiosity of the consumer thereby increasing sales.

With respect to claim 17, all the limitations were addressed above with respect to claims 1-2 and 9-11.

Regarding claim 18, this limitation is taught by claim 13 of the compending application.

Regarding claim 19, claim 11 of the compending application teaches the indicia relating to collectibles. It would have been obvious to the skilled artisan at the time the invention was made to having the underside printing on the opaque member of Kagami relate to collectibles because such is known in the art, as taught by Ruemer, wherein this peeks the curiosity of the consumer thereby increasing sales.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

20. Applicant's arguments filed 12/17/03 have been fully considered but they are not persuasive.

21. On page 8 of the arguments, Applicants argue that Bozlee is non-analogous art because it is directed to a bag handle and not a protective member for beverage containers; therefore the skilled artisan would not look to this reference.

The examiner points out that Bozlee was only relied upon for its teaching of a particular business method (selling advertising rights) and not for the product upon which the advertising is placed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


Jessica L. Rossi
Patent Examiner
Art Unit 1733